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REMARKS

In the Office Action of September 29, 2004, the Examiner has objected to claim 1 for a stated informality. Claims 1-3, 5 and 8-10 are rejected under 35 USC 102(a) as being anticipated by Costello (US 2002/0007225). Claims 4, 6 7 and 11-17 are rejected under 35 USC 103(a) as being unpatentable over Costello in view of Huang (U.S. 5,953,707).

The Office Action of September 29, 2004, has been carefully considered and by this amendment, entry of which is respectfully requested, claims 1-20 remain in the application; claim 1 has been amended. The amendment does not add new matter.

In the Office Action, the Examiner has stated that claim 1 has a phrase that is grammatically incorrect. Claim 1 has been amended to correct the noted informality.

Applicant respectfully traverses the rejection of claims 1-17 under 35 USC §102(a) or 35 USC §103(a), for the reason that the cited art does not teach, anticipate, or render obvious the invention of Applicant, as now claimed.

The test for determining if a cited document anticipates a claim, for purposes of a rejection under 35 USC §102, is whether the cited document discloses all of the elements of the claimed combination, or the mechanical equivalents, functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals of the Federal Circuit in Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick, 221 USPQ 481, 485 (1984), in evaluating the sufficiency of an anticipation rejection under 35 USC §102:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

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Furthermore, it is noted in MPEP Section 706 that the standard of patentability to be followed in the examination of a patent application is that which was enunciated by the Supreme Court in Graham v. John Deere, 148 USPQ 459 (1966), where the Court stated:

"Under Section 103, the scope and the content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved."

In considering the Costello document cited by the Examiner, it is respectfully submitted that this document does not anticipate the subject invention. The Costello document claims a computerized system and method for guiding service personnel through the repair steps when working with replacement parts. The Costello publication does not in any way disclose retaining information relating to a specific part, to track the history of the specific part. The subject application discloses and claims the capability of monitoring the status of each part, including whether it needs repair, without guiding a user through repair steps. The cited reference does not teach or suggest knowledge and tools for solving providing significant details of a part, including condition, ownership, quantity, etc. Costello, rather, proposes directing a user through repair steps relating to a family or generic set of parts. It is respectfully submitted, therefore, that independent claims 1 and 11 of the subject application are not anticipated by the cited document.

Even if one were to combine the service personnel guidance method of Costello with the Huang patent, one would

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still not be led to the subject invention. Huang discloses a system for supporting management decisions along a supply chain, but again does not propose tracking specific parts. Huang does not teach, disclose or suggest communicating non-serviceable hardware and repair developments, as does the subject invention.

In light of the amendments and remarks herein, it is respectfully suggested that none of the claims of the subject application are anticipated or obviated by the cited documents, taken singularly or in combination, since the cited documents fail to disclose the elements of the claimed invention, arranged as in the claim, with the purpose defined in the subject application.

Claims 2-8, 10-15 and 17-20 depend from independent claims 1, 9 and 16 to contain all of the limitations found therein. By this dependency, it is submitted that these claims are not anticipated, taught, or rendered obvious by the cited document. Additionally, these claims add further limitations which distinguish them patentably from the cited documents. Accordingly, withdrawal of the rejection of all of the claims of the application is respectfully requested.


Applicants' attorney has reviewed the additional art cited by but not relied upon by the Examiner. That document does not teach, anticipate, or render obvious, when taken singularly or in combination with the relied upon art, the invention of applicants disclosed in the subject application.

In view of the foregoing remarks, the undersigned attorney respectfully submits that all of the claims of the application are clearly allowable. Therefore, Applicant's attorney respectfully requests that the Examiner's

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objections and rejections be withdrawn and that a formal  
Notice of Allowance be issued thereon.

Respectfully submitted,

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